

REMARKS

(1) Summary of Office Action

Claims 1 – 20 were pending in the subject application.

Claims 1 – 11 have been rejected under 35 USC 102(b) as being anticipated by
US Patent 6,234,677 of Mogil;

Claims 3 and 4 are additionally rejected under 35 USC 103(a) as being obvious
given US Patent 6,234,677 of Mogil in view of no less than four
references, namely US Publication 2003 / 0139 169 of Arreazola; US
Patent 6,305,185 of Sloan; US Patent 6,216,488 of Rucker; and US
Patent 5,979,175 of Ellison;

Claims 12 – 13 and 15 – 20 have been rejected under 35 USC 103(a) as being
obvious in light of US Patent 6,234,677 of Mogil in light of US Patent
5,501,338 of Preston;

Claim 14 has been rejected under 35 USC 103(a) as being obvious given US
Patent 6,234,677 of Mogil in light of US Patent 5,020,921 of Beales;

Claims 16, 17, 19 and 20 are also rejected as being obvious under 35 USC
103(a) given US Patent 6,234,677 of Mogil in light of US Patent 5,403,095
of Melk;

The Applicant respectfully traverses all of these rejections, and requests that they
be reconsidered and withdrawn.

(2) Rejections Under 35 USC 102(b)

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

For a reference to anticipate a claim it must clearly show or describe every element of the claimed structure. Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture, *Datascope Corp. v. SMEC Inc.*, *supra*.

Claim 1, from which claims 2 to 11 depend, includes the feature of a reinforcement of the first portion of the container. The Office Action asserts that US Patent 6,234,677 includes a reinforcement, and cites col. 14, line 6 as revealing the feature in question.

The present Applicant, being also the Applicant in US Patent 6,234,677, is well familiar with the reference. Clearly, partition **425** disclosed at line 6 is not a "reinforcement member mounted therewithin [i.e., within the first portion of the soft-sided insulated wall structure] to maintain the first portion in a condition to receive objects in the first enclosed space" as presently claimed. While the law requires that the language

of the claim be given its broadest reasonable interpretation, it must be read in the context of, and not in a manner inconsistent with, both (a) the description in the present specification; and (b) the description in the cited reference.

Partition **425** is designated, and is employed as, a partition in the most literal sense: it partitions the interior of a space into sub-compartments. It is not a reinforcement of the first portion wall generally, and clearly does not function to maintain the first portion in a condition to receive articles.

Nonetheless, out of an abundance of caution, claim 1 has been amended. The Applicant points out that the present application teaches, at paragraph [0004] that the reinforcement gives the first portion of the container a rigid form, and in paragraph [0005] that the first portion of the container is non-collapsible. Paragraph [0007] indicates that the rigid insert provides the contents of the container with protection from external forces. Paragraph [0071] indicates that the rigid insert, receptacle **28**, has a size and shape that corresponds to the size and shape of the compartment **48** defined by the outer soft-sided outer casing **42**. Paragraph [0074] indicated that receptacle **28** is rigid to provide structural reinforcement to casing **42** to protect items stored therein from external forces.

For these reasons the Applicant respectfully submits that the cited reference, US Patent 6,234,677 does not have all of the features of the claim. It cannot therefore serve as a basis for a rejection of claim 1, or of any claim dependent therefrom under 35 USC 102(b). The Applicant therefore requests that each of these rejections be reconsidered and withdrawn.

(3) **Rejections Under 35 USC 103(a)**

The Applicant notes the following principals:

- (a) MPEP 2141.02: VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

- (b) A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

- (c) MPEP 2143.01 V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Principal Reference Teaches Away

All of the rejections of claims 3, 4 and 12 - 20 made under 35 USC 103(a) rely on US Patent 6,234,677 as the principal reference. The Applicant respectfully submits that this reference, if anything, teaches away from the presently claimed invention.

Each of the soft-sided containers described in US Patent 6,234,677, whether single or double, is a foldable (i.e., collapsible) container. Furthermore, all of the double cooler embodiments, namely those of Figures 15 – 31 shown in the reference, are collapsible and securable in the collapsed position. The claims of US Patent 6,237,677 reflect this.

Clearly, a teaching that one of the container portions has a reinforcement that makes that portion rigid, as in the present description and claims, is directly contrary to the teaching of collapsible containers that are securable in the collapsed position. It is also quite inconsistent with the teaching of a liner made from a folded sheet of plastic, also found in the reference. Given that the claimed container has first and second outer portions, and a liner, a person of ordinary skill in the art might reasonably consider a reference that teaches away from either one (let alone both) could fairly be said to teach away from the invention in a “material respect”. As such, the principal reference clearly teaches away from the present invention. As such, US Patent 6,237,677 can not serve as the basis for a rejection under 35 USC 103(a), whether as the primary reference or as a secondary reference. The Applicant therefore respectfully requests that all rejections under 35 USC 103(a) that rely on US Patent 6,237,677 be reconsidered and withdrawn.

Rejection of Claim 16: The Preston Reference

In addition to the foregoing commentary, the Applicant respectfully submits that US Patent 6,237,677 does not merely fail to disclose that the reinforcement member is

a receptacle for accommodating objects, but, rather, fails to disclose the reinforcement at all.

The Office Action suggests that the Preston reference supplies the missing features. The Applicant respectfully disagrees.

As a starting point, the Applicant notes that Preston does not teach a folding container portion of any kind. On the contrary, Preston teaches the use of multiple rigid food tray assemblies inside a thermally insulative cover.

The Applicant respectfully points out that the law still requires the establishment of *prima facie* grounds for rejection according to a three part test. First, the references must show or describe all of the features of the claim. Second, the proposed combination or modification must have a reasonable prospect of success in terms of producing the same apparatus, result or effect as the claimed invention. Third, there must be an objective reason why the proposed combination or modification would be made by the person of ordinary skill in the art. The recent *KSR* decision (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)), points out that the reason need not be found in the reference itself, and need not be the same reason that prompted the inventor to make the claimed invention, rather the reason can be a different reason, it can be found in a reference other than the cited reference, or it can be found in the objectively demonstrable knowledge of persons of ordinary skill in the art or science to which the invention belongs. Nonetheless, there must be an objectively reasonable logical basis for making the proposed combination or modification that would be readily apparent to a person of ordinary skill in the art, reading the references as an whole.

In the present instance, the Applicant points out, again, that all of the soft-sided cooler embodiments shown and described in the principal reference are collapsible coolers, whether in single cooler form or in double cooler form. The Applicant further notes that the claimed invention of the principal reference is for collapsible coolers.

Further, the principal reference teaches a folded liner – over and over and over. The Applicant fails to see how or why a person of ordinary skill in the art would then be led, seemingly rather perversely, to use a rigid liner instead, apparently in defiance of the plain teaching of the reference. Clearly the proposed use of a rigid liner instead runs directly opposite to the teaching of that reference.

In summary, if the rejection is correct, a person skilled in the art would take the rigid liner of Preston, and insert it into one of the portions of the principal reference, even though the resulting structure would (a) make at least one of the collapsible portions no longer collapsible; (b) dispense with the folded liner (or, alternatively, render it redundant – why have both a folded liner and a rigid liner); and (c) no longer fall within the claims of the principal reference (i.e., would make the apparatus no longer suitable for its purpose).

The Applicant respectfully submits that it is unable to see how or why a person skilled in the art would do such a thing, when it is contrary to the thrust of the entire disclosure of the principal reference. The Applicant respectfully submits that the proposed combination would appear necessarily to destroy the claimed invention of the principal reference. As such there can be no reason to make the combination or modification (See: *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

In that light, the Applicant respectfully submits that grounds for rejection on the basis of the combination of Preston and the Applicant's own previous patent have not been established with respect to any of claims 12, 13 or 15 – 20.

Logical Gap in Rejection

The essence of a rejection under 35 USC 103(a) is not that the rejection shows what a person of ordinary skill in the art did do, but rather what they *would have done*, hypothetically, had they had the cited references at the time the invention was made. This is necessarily a speculative exercise. To the extent that it is based on logic, the exercise can only be credible if that logic is internally consistent: it has no credibility if it has internal contradictions.

Here, both claim 1 and claim 16 effectively call for a two part soft-sided cooler that is collapsible on one side, and provided with a reinforcement (e.g., a rigid liner) on the other. The Applicant therefore points out that it is not enough merely to show that a rigid liner can be used in a soft-sided cooler. Here, even if the *In re Gordon* problem could be avoided, the reason to modify or combine must still explain not only why a person of ordinary skill in the art would use a rigid reinforcement in one portion of the cooler, but once having done so must explain also *why they would not use it in the other portion as well*.

That is, if a person of ordinary skill in the art would for whatever reason infer that the rigid liner of the Preston reference should be inserted into one of the container portions of the Applicant's own previous patent, then why would that person not also have precisely the same reason for inserting rigid liners in both collapsible container

portions of US Patent 6,234,677? Why one and not the other? The Applicant respectfully submits that the Office Action does not provide any explanation of this.

The Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 16 and the related rejections of dependent claims 17 to 20.

Rejection of Claim 16: The Melk Reference

The proposed combination of the Melk reference and the subject matter of US Patent 6,234,677 appears to have exactly the same *In re Gordon* problem as the proposed combination with Preston. The installation of Melk's hard sided tub is contrary to the teaching of the principal reference, and would destroy the function of that claimed invention.

Further, the rejection of claims 16, 17, 19 and 20 also has the same logical gap as the proposed Preston combination: why reinforce one container portion, and not the other? Unless the proposed combination is arbitrary and capricious (and therefore not made according to law) this second issue would seem not to be addressed by the Office Action.

For these reasons, the Applicant respectfully requests that the rejection of claim 16 and the related rejections of dependent claims 17, 19 and 20 be reconsidered and withdrawn.

Rejection of Claim 14: The Beales Reference

Claim 14 has been rejected on the basis of a combination of the principal reference and the Beales reference.

In this instance, the problem is that while Beales may show a divider neither the principal reference nor Beales then shows a reinforcement member that is a “receptacle for accommodating objects ...” Thus an element of the claim is entirely missing from the cited references, and from the rejection. The Applicant respectfully submits that a rejection under 35 USC 103 must still account for all the features of the claim. Since the rejection of claim 14 fails to do this, the Applicant respectfully submits that *prima facie* grounds for rejection of claim 14 have not been established. The Applicant therefore requests reconsideration and withdrawal of the rejection.

Further, the claim calls for a “folding divider”. This is not actually what Beales shows and describes. The Applicant respectfully submits that while Beales shows a divider that is formed by folding, that is not at all the same thing as a divider that folds. Once the divider is formed, the locking tabs are in place, and the glue is applied (see Beales Abstract) the folded divider “becomes latched or locked”. It is then manifestly not a “folding divider”.

The Applicant again requests reconsideration and withdrawal of this rejection.

Rejection of Claims 3 and 4: The Rigid Cooler References

Claims 3 and 4 are additionally rejected on the basis of US Patent 6,234,677 in view of four references, namely Arreazola, Sloan, Rucker, and Ellison.

As a preliminary comment, the Applicant respectfully traverses the rejection of claims 3 and 4 under 35 USC 102(b) on the basis of US Patent 6,234,677 alone. The Applicant respectfully submits that while the Applicant admires the resourcefulness and ingenuity of the rejection, the “pen in Figure 15” hardly constitutes “an entertainment

device” even when dressed up in its fanciest clothing under the Rule of Broadest Reasonable Interpretation. Further, the citation of an access port for an electrical connection merely begs the question: why would someone need an electrical connection for a pen ? The Applicant respectfully requests that this ground of rejection be reconsidered and withdrawn.

As for the four references, the Applicant does not dispute that these references each show a radio in a hard sided cooler. The Applicant believes that radios have previously been mounted in soft-sided coolers, and does not claim that the mounting of a radio in a soft-sided cooler is *per se* patentable. However, none of these references cure the above-noted deficiencies of the principal reference and thus, Claims 3 and 4 are allowable as well.

(4) **Claims Amended With Traverse and Without Prejudice to Continuation or Division**

Although the Applicant has amended claim 1 out of abundance of caution to prevent any ambiguity in interpretation, the Applicant respectfully submits that this amendment is not necessary on a properly construed interpretation by a person of ordinary skill in the art of the claim language as it originally stood prior to amendment. The Applicant therefore reserves the right to pursue any one or all of claims 1 - 15 as it, or they, stood prior to the current amendment, by way of continuation or division as may be appropriate.

The Applicant is explicitly not disclaiming claim scope under the doctrine of equivalents by the inclusion of the present amendments.

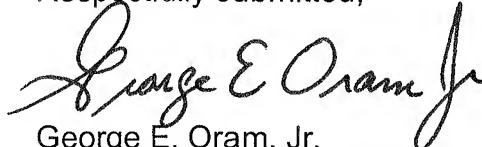
(5) **Conclusion**

In view of the foregoing arguments the applicant again submits that the claims pending in this case are presently in a condition for allowance. Therefore the applicant requests early and favourable disposition of this application.

Applicants respectfully submit that this application is in condition for allowance and such action is earnestly solicited.

In the event that this paper is not being timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 024643-00015.

Respectfully submitted,

A handwritten signature in black ink, reading "George E. Oram, Jr.", written in a cursive style.

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